

REMARKS

Upon entry of the instant amendment, Claims 1 and 3-12 will remain pending in the application, with claims 1, 3-8 and 10-12 standing ready for further action on the merits, and remaining claim 9 being withdrawn from consideration based on an earlier restriction requirement of the Examiner.

In the instant amendment claims 1 and 8 have been amended (support for which may be found in the specification, at least, at page 12, lines 14-15 and in original claim 2); and claims 2 and 13 have been cancelled. No new matter has been added by way of the above amendments.

Provisional Interview Request

Applicants respectfully request to schedule a personal interview with the Examiner if the present response does not serve to place the present application (claims 1, 3-8 and 10-12) in condition for allowance.

Information Disclosure Statement

The Examiner has stated that the information disclosure statement filed July 25, 2007, fails to comply with 37 C.F.R. 1.98(a)(3) because it does not contain a statement of the relevance of the non-English language documents.

However, an English language corresponding document has been provided for each of the patents that are not in the English language as set forth under subsection (III) Concise Explanation of the Relevance, on page 2 of the Information Disclosure Statement filed on July 25, 2007 in

addition to the PTO/SB/08. Applicants believe that the Examiner considered only the PTO/SB/08 and not the Information Disclosure Statement.

Applicants respectfully request that the Examiner consider each of the cited documents and appropriately indicate consideration thereof on the PTO/SB/08.

Rejection under 35 USC § 112

Claims 1, 8 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants respectfully traverse.

Applicants wish to point out that the present invention is characterized in its structure, not in materials to be used. In this regard, claim 1 has been amended to reflect that a binder is used in the base layer, but not used in the surface coating. Therefore, the distinction between these two coatings is clarified. Claim 8 has also been amended for clarification. Claim 13 has been cancelled herein, thus the rejection with respect to this claim is rendered moot.

Applicants respectfully request reconsideration and withdrawal of the outstanding rejection.

Rejections under 35 USC § 102 and 35 USC § 103

Claims 1, 2, 5-8, 10, 12 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by USP 5,783,547 to Wilkinson (“**Wilkinson**”).

Claims 1, 2, 7, 8, 10, 12 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by USP 4,260,651 to Wixon (“**Wixon**”).

Claim 10 stands rejected under 35 U.S.C. §102(b) as being anticipated by USP 5,030,379 to Knight et al. (“**Knight**”).

Claims 1, 2, 7, 8, 10, 12 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by USP 5,853,430 to Shindo et al. (“**Shindo**”).

Claims 1, 2, 7, 10, 12 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by USP 6,015,784 to Kazuta et al. (“**Kazuta**”).

Claims 1, 2, 7, 8, 10 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by USP 6,583,098 to Cassie (“**Cassie**”).

Claims 1-8 and 10-13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Wilkinson**, US Patent 5,783,547.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the

proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and

- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Discussion of Present Invention

An important feature of the present invention is the fact that by forming the base layer where a fine powder is dispersed in a binder on the surface of the base detergent particle, the stripping property of the surface modifier is suppressed while the adhesive property thereof is improved. It is essential to the present invention that the fine powder in the base layer adhering to the surface of the base detergent particles acts as a structural support by its fine rugged surface, and thereby suppresses stripping of the surface modifier which originally has the function of protecting the base detergent particle. Accordingly, a binder is necessary in the base layer so that the fine powder can securely adhere to the surface of the base detergent particle.

Also, since the fine powder structurally supports the surface modifier, the anti-caking property is remarkably improved. These structural features are key points of the present invention so that it is not necessary to limit materials to be used. Such features are disclosed in the specification at page 4, line 22 – page 5, line 14.

Distinctions Over the Cited Prior Art

The present claims have been amended to clarify the scope of the present invention. That is, the fine powder used for the base layer acts like an anchor for supporting the surface modifier as noted above. Accordingly, the average particle size of the fine powder is smaller than that of the surface modifier.

Moreover, none of the cited references teach a detergent particle where the surface coating consists essentially of a surface modifier, which is formed on the base layer. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited, which indicates that each of pending claims 1, 3-8 and 10-12 currently under consideration is allowed and patentable at present under the provisions of Title 35 of the United States Code.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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